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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,120	12/26/2001	Shuichi Matsumoto	252-000007	3429
27572 7590 12/28/2006 HARNESSE, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			EXAMINER HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER

3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/036,120

Applicant(s)

MATSUMOTO ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 11-14, 16-19, 21-24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-14, 16-19, 21-24 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11-7-06</u> . | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-4, 6-9, 11-14, 16-19, 21-24, and 26-28 have been examined.

Response to Amendments/Arguments

2. Applicant has amended the claims to recite a server that is “operable to set use restriction information for all contents of the contents file...”. Although there is nothing inherently wrong in defining something by what it does (*In re Hallman* 210 USPQ 609) and features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished in terms of structure rather than function (MPEP 2114; *In re Schreiber* 44 USPQ2d 1429 (1997)). The term “operable” is synonymous with “practicable”, which is defined as “possible to practice or perform” (Webster’s Ninth New Collegiate Dictionary). Further, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP, 2106, section II, C). Therefore, as it is *possible* for the server of Ginter et al. to set user restriction information for all contents of the contents file, such as the server/computer of the original content creator (column 308, lines 30-35), the prior art continues to read on Applicant’s claimed apparatus and method.

The Examiner recommends that the Applicant consider features described on page 36, line 19- page 37, line 5 of Applicant's Specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-9, 11-14, 16-19, 21-24, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent No. 5,892,900 in view of Erickson, U.S. Patent No. 5,765,152.

As per claims 1-4, 6-9, 11-14, 16-19, 21-24, and 26-28, Ginter et al. teach a contents providing service system comprising:

- contents file that includes encrypted (partial) content (e.g. music) and use restriction information (figure 19; column 135, lines 20-34; column 141, lines 5-25), use allow range and use prohibit range (column 137, lines 50-64; column 155, lines 38-51; column 157, lines 1-13; column 166, lines 25-32; column 294, lines 17-51) and

provisional use prohibit range that provides for conditional use of content after fee payment (figure 72D; column 36, lines 22-38; column 140, lines 25-38; column 160, lines 15-35)

- server supply unit for supplying content to client (column 18, lines 55-63; column 134, lines 39-58; column 315, lines 25-42)
- client apparatus comprising decoding unit and a restricting unit for (figure 7; column 60, lines 7-44; column 62, lines 32-50)
- client apparatus for transmitting to the server apparatus for requesting use of content (figure 72D) and for implementing user restriction (figure 7; column 60, lines 7-44; column 62, lines 32-50)
- server apparatus includes a user approve unit for transmitting a user approval to the client apparatus in response to fee paid and allows client to use content based on restriction information (figure 72D)

Ginter et al. teach content distribution system where content usage is determined by rights or restriction (column 9, lines 20-24). However, Ginter et al. do not specifically recite "representation modes". Erickson teaches a content distribution system that allows users to obtain additional rights that allow users to process content using varying representation modes (figures 1, 5A-B, and 7A-D).

Therefore, it would have been obvious to one of ordinary skill to combine the

teachings of Ginter et al. and Erickson in order to allow content providers to receive additional revenues for use, such as modification, of their content.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Calvin Hewitt II", written over the printed name.

Calvin Loyd Hewitt II
Primary Examiner

December 19, 2006